

REMARKS / DISCUSSION OF ISSUES

Claims 1-6 are pending in the present application. No amendments are made to the claims in the present Response.

Objection to the Drawings

Applicants gratefully acknowledge the withdrawal of the drawing objections set forth in the previous Office Action.

Rejections under 35 U.S.C. § 112

Applicants gratefully acknowledge the withdrawal of the rejections under this section of the Code set forth in the previous Office Action.

Rejections under 35 U.S.C. § 102

Claim 1 was rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by *Gibson, et al.* (U.S. Patent 4,977,346). For at least the reasons set forth below, Applicants respectfully submit that all claims are patentable over the applied art.

At the outset Applicants rely at least on the following standards with regard to proper rejections under 35 U.S.C. § 102. Notably, a proper rejection of a claim under 35 U.S.C. § 102 requires that a single prior art reference disclose each element of the claim.¹ Anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference² or embodied in a single prior art device or practice.³ For anticipation, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention.⁴

1 See, e.g., *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983).

2 See, e.g., *In re Paulsen*, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994); *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990).

3 See, e.g., *Minnesota Min. & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992).

4 See, e.g., *Scripps Clinic & Res. Found. v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ2d 1001 (Fed. Cir. 1991).

Claim 1 recites:

A high-pressure discharge lamp comprising:
an outer envelope in which a discharge vessel is arranged around a longitudinal axis,
the discharge vessel enclosing, in a gastight manner, a discharge space provided with an ionizable filling,
the discharge vessel having a first and a second mutually opposed neck-shaped portion through which a first and a second current-supply conductor, respectively, extend to a pair of electrodes arranged in the discharge space,
the outer envelope having a bulb-shaped portion adjacent the discharge space,
the bulb-shaped portion having a wall thickness d_1 ,
the remainder of the outer envelope having a wall thickness d_2 , wherein the high-pressure discharge lamp does not comprise a shield for containing a burst of the discharge vessel (emphasis added)

In rejecting claim 1, the Office Action directs Applicants to the description of Fig. 6 of *Gibson, et al.* for the alleged disclosure of the features of the outer envelope emphasized in claim 1 above. Applicants respectfully disagree.

A review of Fig. 6, and its supporting description at column 7, lines 5-56, fails to disclose the thickness of an outer envelope, let alone the relative thickness in different portions of the outer envelope. While the description of Fig. 5 does disclose a different thickness for end walls of an asymmetrical discharge device, there is no disclosure or suggestion of the thicknesses of an outer envelope as specifically recited in claim 1. To wit, column 6, lines 58-68 discloses:

An asymmetrical discharge device can also be realized with equal electrode tip to end wall distances for both electrodes but with end walls of different thicknesses. The thicker end wall will dissipate more heat than the thinner end wall and thus operate at a lower temperature than the thinner end wall. By making the discharge device end wall that is closer to the envelope dome thicker than the more distant end wall, the heat reflected back from the envelope dome will be dissipated and the sensitivity of lamp operating voltage to position will be diminished.

Accordingly, and for at least the reasons set forth above, Applicants respectfully submit that the applied art fails to disclose at least one feature of claim 1. Therefore, a prima facie case of anticipation has not been established in view of *Gibson, et al.*, and claim 1 is patentable over the applied art.

Rejections under 35 U.S.C. § 103

The rejections of claims 2-6 variously under this section of the Code has been considered. Claims 2-6 depend from claim 1, immediately or ultimately. Since each of the dependent claims depends from a base claim that is believed to be in condition for allowance, Applicant believes that it is unnecessary at this time to argue the allowability of each of the dependent claims individually. Applicant does not, however, necessarily concur with the interpretation of any dependent claim as set forth in the Office Action, nor do Applicant concurs that the basis for the rejection of any dependent claim is proper. Therefore, Applicant reserves the right to specifically address the patentability of the dependent claims in the future, if deemed necessary.

Conclusion

In view the foregoing, applicant(s) respectfully request(s) that the Examiner withdraw the objection(s) and/or rejection(s) of record, allow all the pending claims, and find the application in condition for allowance.

If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted on behalf of:

Phillips Electronics North America Corp.

/William S. Francos/

by: William S. Francos (Reg. No. 38,456)

Date: October 21, 2009

Volentine & Whitt, PLLC
Two Meridian Blvd.
Wyomissing, PA 19610
(610) 375-3513 (v)
(610) 375-3277 (f)